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SERIAL NUMBER 28-34	FILING DATE 10/2/89	FIRST NAMED INVENTOR C. DAVID ENHARDT	ATTORNEY DOCKET NO. 3-21-AMD
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C. DAVID ENHARDT
KUDARD, ENHARDT, NAUGHTON,
MORRIS & MC NETT
ONE INDIANA SQUARE - SUITE 2600
INDIANAPOLIS, IN 46264

EXAMINER

TRULUCK, D

ART UNIT
385

PAPER NUMBER

10/2/89

10/02/89

This is a communication from the examining division of your application.
CO-OPERATION IN PATENT PROCEDURE

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 28-34 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-27 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 28-34 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit 336

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one (1) year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 28-34 are rejected under 35 U.S.C. 102(b), (e) as being anticipated by Hammerslag or Rockey respectively.

Hammerslag shows expanding a self retaining stent sleeve L within a blood vessel at a point of stenosis by means of a balloon catheter. The stent of Hammerslag is expanded without any change in length of the stent during such expansion and obviously retains its expanded position to keep the stenosis open. Rockey shows a tubular stent 51 that is inelastically expanded into a stenotic area of a blood vessel by balloon catheter 50. No change in length occurs within the Rockey stent during expansion.


It is to be noted that applicant endeavors to promulgate an interference with U.S. patent number 4,733,665 (Palmaz) and proposes claims 31-34 as the prospective counts. It is to be noted, however, first that such claims are not patentable to applicant as

stated supra and second, said claims omit several material limitations of the alleged conflicting claims of Palmaz (claims 1, 7, 13, 18, 23 and 26). It is also not apparent that these limitations are necessarily immaterial in nature since in particular, new claims 31, 32 omit the intersecting elongate members which form the wall of the Palmaz graft. This limitation is considered very material since this forms the actual structure of the graft Palmaz obviously considered as his invention. Applicant obviously has no support in his disclosure for such a limitation. The new method claims 33, 34 while closer in scope to claims 1 and 7 of Palmaz also differ in terminology by calling for insertion of a stent as opposed to a graft or prosthesis. A stent has a somewhat different meaning as opposed to graft or prosthesis since a stent can connote a temporary device as opposed to a permanent type implant so that such changes in terminology are not necessarily insignificant.

The PTO 1449 prior art forms supplied by applicant are incomplete in that the proper class and subclass for each patent is not provided. Applicant is requested to supply duplicates including the proper class and subclass designations.

D. Truluck:rms
703-557-3125

September 12, 1989


DALTON L. TRULUCK
PRIMARY EXAMINER
ART UNIT 336